

R E M A R K S

A. INTRODUCTION

Claims 1-19, 31-33 and 35-43 are pending and subject to a restriction requirement in the present Office Action.

Applicants elect Invention II (Claims 3, 4, 11-16 and 38-43) **with traverse**.

B. ELECTION / RESTRICTION REQUIREMENT: ELECTING INVENTION II WITH TRAVERSE

Applicants provisionally elect Invention II (Claims 3, 4, 11-16 and 38-43) **with traverse** in order to comply with the Examiner's restriction requirement, for examination and prosecution on the merits. The non-elected claims are not withdrawn.

The Examiner states that the "inventions" of Groups I - V are "distinct" because each "invention" is related to the other "inventions" as **subcombinations disclosed as usable together** in a single combination." [Office Action, pgs. 3-4.]

The Examiner goes on to state that for each of the "inventions" of Groups I - V, a "separate use" (defined by the Examiner as identical to a particular claimed feature for that "invention") distinguishes the "invention" of a particular group from each of the other "inventions" "since this claimed feature is not limitation of those independently claimed inventions." [Office Action, pgs. 3-4.] The election / restriction requirement thus necessarily depends on findings by the Examiner that a particular limitation claimed in each respective Group is not recited in any of the other defined Groups.

Applicants hereby request reconsideration of the restriction requirement in light of the following arguments, and pursuant to 37 C.F.R. §1.143.

1. The Examiner's Case as Set Forth

The Examiner explicitly states that each and every Group defined by the Examiner was also classified by the Examiner in not only the same class 705, but the same subclass 14. [Office Action, page 2]. In other words, each Group was classified, for purposes of the restriction requirement, in the same class/subclass (705/14).

The Examiner, however, goes on to allege:

Because these inventions are independent or distinct for the reasons given above and there would be a serious burden on the examiner if restriction is not required **because the inventions require a different field of search** (see MPEP § 808.02), restriction for examination purposes as indicated is proper.

[Office Action, page 5 (emphasis added)]. Even though each alleged “invention” was classified in the **same** class/subclass (705/14), the only explanation articulated as to why examination of all the “inventions” would be a “serious burden” was, confusingly, that each invention requires a **different** field of search.

With respect to Groups I and II-V being allegedly “distinct” for allegedly being related as subcombinations disclosed as usable together, the Examiner states: “Group I has separate utility such as determining by a point-of-sale terminal comprising a cash register an upsell. This separate use distinguishes the invention of Group I from Group II-V since this claimed feature is not limitation of those independently claimed inventions. Therefore the invention of Group I is a separately useable subcombination.” [Office Action, pg. 3].

With respect to Groups II and I, III-V being allegedly “distinct” for allegedly being related as subcombinations disclosed as usable together, the Examiner states: “Group II has separate utility such as a processor embodied in a cash register to receive a purchase of an item; determining an upsell based on the item determining a rounded price and providing an offer. This separate use distinguishes the invention of Group II from Group I, III-V since this claimed feature is not limitation of those independently claimed inventions. Therefore the invention of Group II is a separately useable subcombination.” [Office Action, pg. 3].

With respect to Groups III and I, II and IV-V being allegedly “distinct” for allegedly being related as subcombinations disclosed as usable together, the Examiner states: “Group III has separate utility such as receiving, at a point-of-sale terminal a purchase that includes at least one item in which the point-of-sale terminal comprises a cash register. This separate use distinguishes the invention of group III from group I, II, IV-V since the claimed feature is not limitation of those independently claimed inventions. Therefore the invention of Group III is a separately useable subcombination.” [Office Action, pgs. 3-4].

With respect to Groups IV and I-III, V being allegedly “distinct” for allegedly being related as subcombinations disclosed as usable together, the Examiner states: “Group IV has separate utility such as selling, at a point-of-sale terminal comprising of cash register, the at least one item and the upsell for the rounded price. This separate use distinguishes the invention of group IV from group I-III, V since the claimed feature is not limitation of those independently claimed inventions. Therefore the invention of Group III is a separately useable subcombination.” [Office Action, pg. 4].

With respect to Groups V and I-IV being allegedly “distinct” for allegedly being related as subcombinations disclosed as usable together, the Examiner states: “Group V has separate utility such as receiving, at a point-of-sale terminal, a

purchase that includes at least one item. This separate use distinguishes the invention of group V from group I-IV since the claimed feature is not limitation of those independently claimed inventions. Therefore the invention of Group III is a separately useable subcombination.” [Office Action, pg. 4].

The Examiner further states:

Examiner considers that since applicant independently claim the invention of this group, it is *prima facie* showing that the inventions are intended to be independent and distinct and are shown to be separately usable.

[Office Action, page 4]. No MPEP citation, regulatory, or case law authority was provided in support of this novel finding based on the form (rather than the substance) of Applicants’ claims.

2. Establishing a *Prima Facie* Case for Restriction

Applicants respectfully submit that the Examiner has failed to establish a *prima facie* case for restriction.

2.01. Proper Basis for Restriction

Generally

Restriction is proper only where an application contains claims directed to two or more independent or distinct inventions. MPEP §802.01. The term "independent" is defined as meaning "that there is no disclosed relationship between the two or more subjects disclosed, that is, they are unconnected in design, operation, or effect". MPEP §§802.01, 806.06. To establish a *prima facie* case for restriction where the basis for restriction is that the different inventions being claimed are "independent", the Examiner must demonstrate "the reasons...why the inventions as claimed are...independent". MPEP §808.01. The term "distinct", as used in restriction practice, means that two or more claimed subjects are "(1) capable of separate manufacture, use or sale; and (2) are patentable over each other". *Id.* To establish a *prima facie* case for restriction where the basis for restriction is that the inventions are "distinct", the Examiner must establish (1) "the reasons (as distinguished from the mere statement of conclusion) why the inventions *as claimed* are...distinct", and (2) "the reasons for insisting upon restriction therebetween". MPEP §808.01.

Subcombinations Usable Together

In some cases, claims may be directed to subcombinations disclosed as usable together. To support a restriction requirement for claims directed to subcombinations usable together, the Examiner must show all of the following: (i) the subcombinations are “separately usable”, (ii) the “subcombinations do not

overlap in scope”, and (iii) the subcombinations “are not obvious variants”. MPEP §806.05(d).

Where an Applicant presents claims directed to plural subcombinations disclosed as “usable together in a single combination and claims a combination that requires the particulars of” one of the subcombinations, “both two-way distinctness and reasons for insisting on restriction are necessary”. *Id.* For restriction to be proper in such a case, the Examiner must show that “[e]ach subcombination is distinct from the combination as claimed”. *Id.* Such distinctness is established if the Examiner shows: “(A) the combination does not require the particulars of the subcombination as claimed for patentability (e.g., to show novelty and unobviousness), and (B) the subcombination can be shown to have utility either by itself or in another materially different combination.” *Id.* Further:

Where subcombinations as disclosed and claimed are both (a) species under a claimed genus and (b) related, then the question of restriction must be determined by both the practice applicable to election of species and the practice applicable to related inventions. If restriction is improper under either practice, it should not be required (MPEP § 806.04(b)).

If applicant proves or provides an argument, supported by facts, that the other use, suggested by the examiner, cannot be accomplished or is not reasonable, the burden is on the examiner to document a viable alternative use or withdraw the requirement.

MPEP §806.05(d).

3. **The Examiner has Failed to Establish a Serious Burden: Identical Classification in 705/14**

Even if a *prima facie* case for restriction establishes that an application includes independent or distinct inventions, restriction is not proper “[i]f the search and examination of [the] entire application can be made without serious burden.” MPEP §803.

Applicants respectfully assert that restriction is not proper in this case because there is no indication that any serious burden exists. **Further, the Office Action clearly indicates that no serious burden exists.** In particular, each of the alleged claim groups has been given the exact same classification (705/14). Accordingly, contrary to what is asserted, examination of all the alleged groups would not necessitate a separate field of search. The Examiner also has not established by substantial evidence that the alleged claim groups are not related to any class of invention which has achieved a separate status in the art. See, MPEP §808.02.

Thus, even if the Examiner had set forth a *prima facie* case for restriction, **restriction** would still **not** be **proper** in this case, as the findings in the Office Action clearly indicate there would not be a serious burden.

4. No Prima Facie Case – "Independent" Restriction

The Examiner makes no statements alleging that the claimed inventions are "independent". However, even if the Examiner had intended to impose the restriction based on "independent" inventions, the *prima facie* burden has not been met.

Applicants respectfully point out that "independent" inventions, as defined in restriction practice, are "not connected in design, operation, or effect." MPEP §§802.01, 806.06. An example of "independent" inventions would be claims directed to both "an article of clothing and a locomotive bearing". MPEP §806.06. Clearly, where all currently claimed embodiments are generally directed to providing upsells, no such independence exists.

5. No Prima Facie Case – "Distinct" Restriction

If the Examiner had intended to impose the restriction based on "distinct" inventions, the *prima facie* burden has not been met. No reasons for believing the separate alleged groups of claims are "distinct" have been set forth, nor has the second requirement of presenting reasons for insisting upon restriction been complied with.

The Examiner has failed to show that (1) that each claimed invention "has attained recognition in the art as a separate subject for inventive effort, and also a separate field of search", (2) that even if classified together they have formed separate subjects for inventive effort, or (3) that a different field of search is required. MPEP §808.02.

In particular, where "the classification is the same and the field of search is the same and there is no clear indication of separate future classification and field of search, no reasons exist for dividing among related inventions." MPEP §808.02.

Absent any such showings as required by MPEP §808.02, no *prima facie* case for restriction under the "distinct" theory is established.

6. No Prima Facie Case – "Subcombinations Usable Together" Restriction

The Examiner has not met the *prima facie* burden for restriction among any of the defined Groups I-V. For example, the Examiner has not shown "both two-way distinctiveness" nor provided "reasons for insisting on restriction." MPEP §806.05(d). Nor has the Examiner properly addressed the three (3) requirements for establishing distinctness between subcombinations disclosed as usable together.

With respect to the first requirement that the subcombinations be separately usable (MPEP §806.05(d)), the Examiner merely recites limitations of the claims. The Examiner's findings, however, are insufficient to establish a *prima facie* case that any of the alleged subcombinations is separately usable from any other.

For example, the limitation cited from Group II is a species of the limitation from Group I – *i.e.*, receiving a purchase of an item by a processor embodied in a cash register, and determining an upsell by the processor embodied in the cash register, are species of receiving a purchase of an item, and determining an upsell by a point-of-sale terminal that comprises a cash register. The Examiner provides no evidence, argument, nor support for why, or how, these particular recited functions are believed to be separately usable. Accordingly, restriction in this case is not proper.

The Examiner entirely ignores the second requirement that the subcombinations do not overlap in scope (MPEP §806.05(d)). The Examiner provides no evidence, argument, nor support for why, or how, the alleged subcombinations are believed to not overlap in scope. Applicants respectfully note that at least some of the restricted claims from the recited groups do indeed overlap in scope. All claims from each Group, for example, are directed generally to providing upsells (or upsell offers). Accordingly, restriction in this case is not proper.

The Examiner also entirely ignores the third requirement that the subcombination be non-obvious variants (MPEP §806.05(d)). The Examiner provides no evidence, argument, nor support for why, or how, the alleged subcombinations are believed to be non-obvious variants. Accordingly, restriction in this case is not proper.

C. PETITION FOR EXTENSION OF TIME TO RESPOND & AUTHORIZATION TO CHARGE APPROPRIATE FEES

We do not believe that any fees are necessary for this response.

Please grant a petition for any extension of time required to make this Response timely. Please also charge any other appropriate fees set forth in 37 C.F.R. §§ 1.16 – 1.18 for this paper and for any accompanying papers to:

Deposit Account: 50-0271

Order No.: 01-023

Please credit any overpayment to the same account.

D. CONCLUSION

It is submitted that all of the claims are in condition for allowance. The Examiner's consideration is respectfully requested.

If the Examiner has any questions regarding this paper or the present application, the Examiner is cordially requested to contact Michael Downs at telephone number (203) 461-7292 or via electronic mail at mdowns@walkerdigital.com.

Respectfully submitted,

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Date

/Michael Downs 50252/
Michael Downs
Attorney for Applicants
Registration No. 50,252
mdowns@walkerdigital.com
(203) 461-7292 /voice
(203) 461-7300 /fax